**Box APPEAL BRIEF**
**EXPEDITED PROCEDURES EXAMINING**
**GROUP 2623**

PATENT
0630-1845P

*IN THE U.S. PATENT AND TRADEMARK OFFICE*

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| Applicant: | Jong-Hyun YOON | Conf. No.: | 1937 |
| Appl. No.: | 10/667,383 | Group: | 2623 |
| Filed: | September 23, 2003 | Examiner: | J. R. Schnurr |
| For: | METHOD FOR PREVENTING DISCONNECTION OF AUDIO/VISUAL STREAM IN HOME NETWORK | | |

**BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37**

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under § 41.37(a) and 37 CFR §1.136(a), this brief is filed within two months of the Notice of Appeal filed in this case on June 26, 2008, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

EEHC/RJW/jmc

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205:

I. Real Party In Interest
II. Related Appeals and Interferences
III. Status of Claims
IV. Status of Amendments
V. Summary of Claimed Subject Matter
VI. Grounds of Rejection to be Reviewed on Appeal
VII. Argument
VIII. Claims
IX. Evidence
X. Related Proceedings
Appendix A. Claims
Appendix B: Evidence
Appendix C: Related Proceedings

## I. Real Party in Interest

The real party in interest for this Application is LG Electronics Inc., as evidenced by an Assignment recorded on September 23, 2003 at Reel 014545, Frame 0806.

## II. Related Appeals and Interferences

To the best of Appellants' knowledge, there are no other prior or pending appeals of this Application, or patent interference proceedings, or judicial proceedings which may be related to, directly affect, or be directly affected by, or have a bearing on the Board's decision of this Appeal.

## III. Status of Claims

In the Application on appeal, claims 2-18 are pending. Previously pending claim 1 has been canceled. Claims 2, 6 and 18 are independent. Claims 2-18 are finally rejected and are on appeal.

## IV. Status of Amendments

The Amendment under 37 C.F.R. §1.116, filed on May 27, 2008, has been entered and sets forth pending claims 2-18.

## V. Summary of the Claimed Subject Matter

Claim 2 positively recites a method for outputting A/V streams onto a screen in response to a user's request by a home network which includes a server for outputting audio/video streams and plural renderers connected to the server through a home network, comprising:

a step in which a renderer connected to a server requests A/V streams (shown in step S100 of Fig. 3, and described on page 7, lines 20-22);

a step in which the server judges whether A/V streams can be outputted in response to the request from the renderer (shown in step S110 of Fig. 3 and described on page 7, lines 22-24); and

a step in which the server provides the A/V streams to the renderer sequentially or simultaneously if the A/V stream can be outputted (shown in step 120 of Fig. 3, and described from page 7, line 24 to page 8, line 1), or outputting a server unavailablness message to the renderer if the server judges that the A/V streams cannot be outputted (shown in step S130 in Fig. 3 and described from page 7, line 24 to page 8, line 3),

wherein, in the step of judging whether A/V streams can be outputted (shown in step S110 of Fig. 3 and described on page 7, lines 22-24), the server compares transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams(as described, for example, on page 8, lines 13-20), and then judges whether the A/V streams can be outputted (as described, for example, on page 8, from line 21 to page 9, line 22).

Claim 6 positively recites a method for outputting A/V streams onto a screen in response to a user's request by a home network which includes a server for outputting audio/video streams and plural renderers connected to the server through a home network, comprising:

a step in which a renderer connected to a server requests A/V streams (shown in step S100 of Fig. 3, and described on page 7, lines 20-22);

a step in which the server judges whether A/V streams can be outputted in response to the request from the renderer (shown in step S110 of Fig. 3 and described on page 7, lines 22-24); and

a step in which the server provides the A/V streams to the renderer sequentially or simultaneously if the A/V stream can be outputted (shown in step 120 of Fig. 3, and described from page 7, line 24 to page 8, line 1), or outputting a server unavailablness message to the renderer if the server judges that the A/V streams cannot be outputted (shown in step S130 in Fig. 3 and described from page 7, line 24 to page 8, line 3),

wherein, in the step of judging whether A/V streams can be outputted, the server compares the overall transfer rate of the A/V streams being reproduced and a predetermined A/V stream transfer rate on the basis of the distance between a position where the A/V stream requested by the renderer has been recorded and a position where the A/V stream being reproduced has been recorded (as described on page 8, lines 16-20).

Claim 18 positively recites a method for outputting streams through a home network, the method comprising:

connecting plural renderers to a server request A/V streams (shown in step S100 of Fig. 3,

and described on page 7, lines 20-22);

judging, by the server, whether the A/V streams can be outputted in response to requests from the renderers (shown in step S110 of Fig. 3 and described on page 7, lines 22-24); and

providing, by the server, the A/V streams to the renderers sequentially or simultaneously when the A/V streams can be outputted (shown in step 120 of Fig. 3, and described from page 7, line 24 to page 8, line 1),

wherein, in judging whether A/V streams can be outputted, the server compares a transmission time of entire A/V streams and a stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted based on a result of the comparison (as described on page 8, lines 16-20).

## VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 2-4, 8 and 11-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed").

2. Claims 6 and 7 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. Patent 6,917,569 to Lam et al. ("Lam"). These claims do not stand or fall with any other claims for reasons presented, below.

3. Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. Patent 6,189,071 to Bachmat. These claims do not stand or fall with claim 2 for reasons discussed, below.

4. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. patent 5,822,530 to Brown.

## VII. Argument

Initially, Appellants respectfully submit that the claims do not stand and fall together. In this regard, Appellants present three separate sets of arguments with respect to the first three sets of rejections discussed below. For this reason, claims 2-4, 8 and 11-18 do not stand or fall with claims 6 and 7, and do not stand or fall with claims 5 and 9. Similarly, claims 5 and 9 to not stand or fall with respect to either claims 6 and 7 or claims 2-4, 8 and 11-18. Similarly, claims 6 and 7 do not stand or fall with respect to either claims 5 and 9 or with respect to claims 2-4, 8 and 11-18. However, claim 10 stands or falls with respect to claim 2.

1. Claims 2-4, 8 and 11-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed"). This rejection is improper and should be reversed.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is "the invention as a whole," not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under Section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. *See In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir.

1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *See Medtronic, Inc. v. Cardiac Pacemakers. Inc.*, 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal Inc. v. F-Wiley Corp.*, 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refactories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations

must be suggested or taught by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *See In re Dembiczak*, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. *See In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the Applicant to come forward to rebut such a case.

With respect to claim 2, Applicant respectfully submits that none of the applied references discloses or suggests the combination of features recited in claim 2, including in which the server judges whether A/V streams can be outputted in response to the request from the renderer; and a

step in which the server provides the A/V streams to the renderer sequentially or simultaneously if the A/V stream can be outputted, or outputting a server unavailableness message to the renderer if the server judges that the A/V streams cannot be outputted, wherein, in the step of judging whether A/V streams can be outputted, the server compares transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted.

Giammaressi is limited to determining bitrates for different quality levels of its data stream but contains no disclosure of comparing the transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted. The final Office Action states that this feature is disclosed by Giammaressi's disclosure of steps 210 and 214. The final Office Action, on page 2, indicates that Giammaressi clearly teaches determining the total load on at least one of the video server resources, including data storage, and it is then determined if the introduction of the newly requested video stream would exceed the bandwidth limit of the device, referencing col. 6, lines 14-44.

In response to this argument, Applicant respectfully submits that the Office has not met its burden of making out a *prima facie* case that "determining the total load on at least one of the video services resources" anticipates the claimed invention, which positively recites a combination of features, including wherein the server compares transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted.

In order for a reference to anticipate a claim, that reference must disclose what is claimed, either explicitly or inherently. Most certainly Giammaressi does not explicitly disclose "wherein . . . the server compares transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted," as claimed.

Moreover, in order to inherently anticipate a claim, a reference must not just possibly, or not just probably, but necessarily disclose what is claimed. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

As stated in col. 6, lines 18+ of Giammaressi, ". . . a determination is made as to the amount of bandwidth required, from each of at least one bandwidth constrained resource, to process the request. This determination also considers the existing load placed upon the at least one bandwidth constrained resource due to other requests presently being satisfied by the information provider."

Giammaressi mentions nothing about a server comparing transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, as claimed, and the Office Action does not explain how or why determining an amount of bandwidth requirement from a bandwidth constrained resource and the existing bandwidth load due to other requests is the same as a server comparing transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams.

The Office tries to support its position by referencing, in the Advisory Action mailed on June 18, 2008, the definition of bandwidth in the 1997 edition of the Microsoft Computer Dictionary, a copy of which has not been provided to Appellants for the proposition that bandwidth is defined as the data transfer capacity of the server. However, this definition of bandwidth does not mention the claimed "a defined reproduction capability of the server required for reproducing A/V streams." Another way of stating this is that in the applied art and in the dictionary relied on in the Advisory Action, bandwidth is defined in terms of transmission of data, not in terms of data reproduction or in terms of a defined reproduction capability of a server. Not only does Giammaressi not explicitly disclose this positively recited feature of the claims, but neither does the Microsoft Computer Dictionary on which the Examiner relies in an attempt to show that Giammaressi inherently discloses the claimed invention.

Applicant respectfully submits that server bandwidth for one-to-many Video on Demand (VOD) systems, such as Giammaressi's is typically found by multiplying the number of simultaneous users by the average bitrate of encoded A/V content. See, for example, the enclosed four page Flash media Server Article from the Adobe Developer Center. In view of this, Applicant does not understand, and the Office Action does not explain how or why, Giammaressi's bandwidth load determinations necessarily (i.e., not just possibly and not just probably) anticipates the claimed invention.

Simply stating that Giammaressi makes bandwidth determinations does not make out a *prima facie* case of anticipation/obviousness of this aspect of the claimed invention, i.e., comparing transmission time of entire A/V streams and A/V stream transmission time according to a defined

reproduction capability of the server required for reproducing A/V streams.

Goldthwaite, the secondary reference, is applied to teach a home network. However, Goldthwaite only discloses a home network as one example of a network that is usable with its invention, where Goldthwaite's invention concerns correlating a network user's collected data in a historical format, which has nothing to do with the primary reference, which determines if requested information can be provided to a network subscriber. In other words, Goldthwaite has nothing to do with determining whether requested information can be provided to a network subscriber and, for at least this reason, one of ordinary skill in the art would have no proper incentive to look to Goldthwaite to modify Giammaressi's system to use it in a home network.

In response to this argument, the Office Action asserts that Giammaressi discloses in col. 5, lines 8-10 that any network may be used with its disclosed invention. Based on this the Examiner concludes that it would be obvious to use Goldthwaite's home network in Giammaressi. Appellants respectfully disagree with what Giammaressi discloses in this regard. Actually, Giammaressi discloses that networks which use different signal transmission media, e.g., fiber optic networks, telephone networks and cable TV networks can use its invention. In other words, Giammaressi does not disclose that any network can be used with its disclosed invention. There is no mention of a home network in Giammaressi, which is limited not by the type of transmission medium, but by the structure in which it is located. No such teaching is found in Giamaressi.

As pointed out by the Court of Appeals for the Federal Circuit, one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the

claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988). Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, which is the essence of improper hindsight.

Seed, the tertiary reference, is applied to disclose outputting an unavailable message if a server judges that A/V streams cannot be outputted. However, Seed fails to remedy the aforementioned shortcoming in Giammaressi.

Moreover, Goldthwaite also fails to remedy the aforementioned fundamental shortcoming of Giammaressi.

So, even if one of ordinary skill in the art were properly motivated to modify Giamaressi in view of Goldthwaite and Seed, as suggested in this rejection, the resulting modified version of Giammaressi would skill not render the claimed invention obvious.

Further, with respect to claims 4, 11 and 11-18, the Office Action includes a reference to U.S. Patent 5,671,377 to Bleidt. Based on the Examiner's responsive arguments, Applicant agrees that Bleidt is incorporated by reference into Giammaressi. However, the entire concept of a server comparing a transmission time of entire A/V streams and a stream transmission time according to a defined reproduction capability of the server is missing from each applied reference, so, no matter how they are combined, they cannot possibly result in, suggest, or otherwise render obvious, the claimed invention.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claim 2 or claims 3, 4, 8 and 11-18, which depend

from claim 2.

Reconsideration and reversal of this rejection of claims 2-4, 8 and 11-18 are respectfully requested.

2. Claims 6 and 7 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. Patent 6,917,569 to Lam et al. ("Lam"). This rejection is improper and should be reversed.

Initially, Applicant respectfully submits that the aforementioned Giammaressi-Goldthwaite-Bleidt-Seed reference combination does not make out a *prima facie* case of obviousness of the subject matter of claim 2, for reasons stated above. Applicant also agrees with the admission in the Office Action that the Giammaressi-Goldthwaite-Seed reference combination applied in the rejection of claim 1 does not disclose wherein, in the step of judging whether A/V streams can be outputted, the server compares the overall transfer rate of the A/V streams being reproduced and a predetermined A/V stream transfer rate on the basis of the distance between a position where the A/V stream requested by the renderer has been recorded and a position where the A/V stream being reproduced has been recorded, as claimed.

In an attempt to remedy this deficiency, the Office Action turns to Lam, which is directed to managing a disk array storage device by using dynamic reallocation of data on a disk array storage device based on actual usage (col. 3, lines 15-17) and has no disclosure whatsoever of

judging whether AV streams can be output to a renderer. Unfortunately, the Office Action never convincingly explains why one of ordinary skill in the art would be motivated to modify the base reference combination, which never discusses managing a disk array storage device, by turning to a disk array storage device managing system, in general, or by determining hard drive seek times to judge whether A/V streams can be outputted to a renderer. The alleged motivation to make the proposed modification of the base reference combination is "for the benefit of providing dynamic disk allocation based on actual usage." Unfortunately, the Office Action fails to demonstrate that a user of the base reference combination's server has a disk array that has a need for dynamic disk allocation or would be motivated to determine whether AV streams can be output to a renderer, or that Lam discloses being used to determine whether AV streams can be output to a renderer. In other words, the basis for the proposed combination of references is not found in the references themselves. Accordingly the only apparent basis for the proposed reference combination is either unwarranted speculation or impermissible hindsight reconstruction of the Applicant's invention based solely on Appellants' disclosure, which cannot properly be used against them.

In fact, instead of addressing the invention recited in claim 6, the Office Action only tries to address the admitted shortcoming of the applied references to disclose determining the read time from the storage unit based on a distance between two memory locations. Unfortunately, this is not what is claimed. The claimed invention is reproduced above, and recites a combination of features, including wherein, in the step of judging whether A/V streams can be outputted, the server compares the overall transfer rate of the A/V streams being reproduced and

a predetermined A/V stream transfer rate on the basis of the distance between a position where the A/V stream requested by the renderer has been recorded and a position where the A/V stream being reproduced has been recorded, as claimed. For example, "a position where the A/V stream requested by the renderer has been recorded and a position where the A/V stream being reproduced has been recorded", as claimed, is far more detailed that the target set up by the Examiner to achieve, i.e., two memory locations. In other words, the rejection never even tries to render the claimed invention obvious. Rather, it improperly redefines the invention and merely tries to render that not-claimed invention obvious.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 6 and 7.

Reconsideration and reversal of this rejection of claims 6 and 7 are respectfully requested.

3. Claims 5 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. Patent 6,189,071 to Bachmat. This rejection is improper and should be reversed.

Initially, Applicant notes that the Giammaressi-Goldthwaite-Seed reference combination does not render obvious the subject matter of claim 2, from which claims 5 and 9 depend, for the reasons discussed above. Moreover, Bachmat is not applied in this rejection to remedy the afore-noted shortcomings of the Giammaressi-Goldthwaite-Seed reference combination with respect to

claim 2. So, even if one of ordinary skill in the art were properly motivated to modify the Giammaressi-Goldthwaite-Seed reference combination based on Bachmat, as suggested, the so-modified version of the base reference combination would not render the claimed invention obvious.

Furthermore, Bachmat is directed to managing resources in a disk array storage device and has nothing whatsoever to do with judging whether A/V streams can be outputted to a user, especially a user that has not been shown to have a disk array storage device.

Unfortunately, the Office Action never explains why one of ordinary skill in the art would be motivated to modify the base reference combination, which never discusses managing a disk array storage device, by turning to a disk array storage device managing system, in general, or by determining hard drive seek times to judge whether A/V streams can be outputted to a renderer. The alleged motivation to make the proposed modification of the base reference combination is "for the benefit of providing dynamic disk allocation based on actual usage." Unfortunately, the Office Action fails to demonstrate that a user of the base reference combination's server has a disk array that has a need for dynamic disk allocation or would be motivated to determine whether AV streams can be output to a renderer. In this regard, Lam has no disclosure of being used to determine whether AV streams can be output to a renderer.

In response to these arguments, the final Office Action indicates that Giammaressi incorporated by reference, the Bleidt reference, which discloses managing a disk array storage device. However, no matter what disk array storage device management techniques are used by Bleidt, none of the references discloses the subject matter of claim 2, from which claims 5 and 9

depend.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claims 5 and 9.

Reconsideration and reversal of this rejection of claims 5 and 9 are respectfully requested.

4. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 7,086,077 to Giammaressi in view of U.S. Patent Application Publication 2003/0154480 to Goldthwaite et al. ("Goldthwaite") and further in view of U.S. Patent Application Publication 2006/0015574 to Seed et al. ("Seed") and further in view of U.S. patent 5,822,530 to Brown. This rejection is improper and should be reversed.

Initially, Applicant notes that the Giammaressi-Goldthwaite-Seed reference combination does not render obvious the subject matter of claim 2, from which claim 10 depends, for the reasons discussed above. Moreover, Brown is not applied in this rejection to remedy the afore-noted shortcomings of the Giammaressi-Goldthwaite-Seed reference combination with respect to claim 2. So, even if one of ordinary skill in the art were properly motivated to modify the Giammaressi-Goldthwaite-Seed reference combination based on Brown, as suggested, the so-modified version of the base reference combination would not render the claimed invention obvious.

Accordingly, the Office Action fails to make out a *prima facie* case of obviousness of the subject matter recited in currently pending claim 10.

Reconsideration and reversal of this rejection of claim 10 is respectfully requested.

## VIII. Claims

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A include the amendments filed by Appellants on May 27, 2008.

## IX. Evidence

Appellants filed a four page Adobe Developer Center Article: Calculating bandwidth needs for Flash media Server as an attachment to the Amendment filed on May 27, 2008.

The Examiner relied upon the Microsoft Press Computer Dictionary, Third Edition, (1997), in the Advisory Action dated June 16, 2008, but no copy was provided to Appellants.

## X. Related Proceedings

No related proceedings are referenced in Section II, above.

## ***Conclusion***

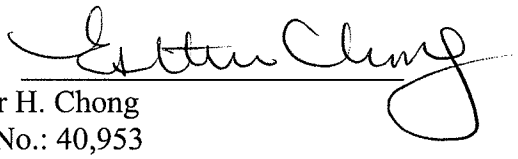
All of the stated grounds of rejection are improper, and should be reversed, for reasons presented above.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: August 25, 2008

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By: 

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## A. Claims Appendix

1. (Canceled)

2. (Previously Presented) A method for outputting A/V streams onto a screen in response to a user's request by a home network which includes a server for outputting audio/video streams and plural renderers connected to the server through a home network, comprising:

a step in which a renderer connected to a server requests A/V streams;

a step in which the server judges whether A/V streams can be outputted in response to the request from the renderer; and

a step in which the server provides the A/V streams to the renderer sequentially or simultaneously if the A/V stream can be outputted, or outputting a server unavailablness message to the renderer if the server judges that the A/V streams cannot be outputted,

wherein, in the step of judging whether A/V streams can be outputted, the server compares transmission time of entire A/V streams and A/V stream transmission time according to a defined reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted.

3. (Previously Presented) The method of claim 2, wherein if the server's transmission time is slower than the defined transmission time, the server transfers server unavailableness message to the renderer.

4. (Previously Presented) The method of claim 2, wherein the A/V stream transmission time is time taken for a header to simultaneously read A/V streams stored in a storing medium and output them.

5. (Previously Presented) The method of claim 2, wherein the A/V stream transmission time signifies total amount of time obtained by adding the a seek time taken for a header to move to an address where the A/V stream is positioned, a head activation time taken for the header to select a track in which the A/V stream is stored, a rotation latency time taken for the header to be positioned at a desired sector, and a time taken for the A/V stream read through the header to be transferred to the memory.

6. (Previously Presented) A method for outputting A/V streams onto a screen in response to a user's request by a home network which includes a server for outputting audio/video streams and plural renderers connected to the server through a home network, comprising:

a step in which a renderer connected to a server requests A/V streams;

a step in which the server judges whether A/V streams can be outputted in response to the request from the renderer; and

a step in which the server provides the A/V streams to the renderer sequentially or simultaneously if the A/V stream can be outputted, or outputting a server unavailablness message to the renderer if the server judges that the A/V streams cannot be outputted,

wherein, in the step of judging whether A/V streams can be outputted, the server compares

the overall transfer rate of the A/V streams being reproduced and a predetermined A/V stream transfer rate on the basis of the distance between a position where the A/V stream requested by the renderer has been recorded and a position where the A/V stream being reproduced has been recorded.

7. (Original) The method of claim 6, wherein the server judges a time point where the overall transfer rate for the current reproduction becomes slower than the predetermined transfer rate, and transfers the server unavailableness message sequentially or simultaneously to connected renderers.

8. (Previously Presented) The method of claim 2, wherein, in the step of judging whether A/V streams can be outputted, a reproduction processing capability of the server including a CPU and a memory is judged.

9. (Previously Presented) The method of claim 2, wherein, in the step of judging whether A/V streams can be outputted, the number of A/V streams that can be finally outputted is judged on the basis of the lowest reference of header movement speed, header reading speed and the server's reproduction processing capability, in order to determine whether to transfer the server unavailableness message.

10. (Previously Presented) The method of claim 2, wherein, in the step of outputting the server unavailableness message, if some plural renderers are additionally connected to the server and request A/V streams, the A/V streams are transferred from the server to the renderers in order of the plural renderers' stream transmission request, from a time point when server judges transmission of audio/video streams is not possible, the server outputs the server unavailableness message to a renderer which has requested the A/V streams.

11. (Previously Presented) The method of claim 2, wherein the server is a medium reproducing unit for reproducing an optical recording medium, a hard disk medium or a medium including the optical recording medium and the hard disk medium.

12. (Original) The method of claim 11, wherein the medium reproducing unit reads A/V streams stored in certain positions of the recording medium through at least one or more headers performing a mechanical position movement.

13. (Previously Presented) The method of claim 2, wherein the renderer is a display unit for outputting A/V streams provided from the server on a screen.

14. (Previously Presented) The method of claim 2, wherein the home network is a cable communication network on the basis of ethernet or home PNA, IEEE1394.

15. (Previously Presented) The method of claim 2, wherein the home network is a wireless communication network on the basis of a bluetooth, Wireless1394, HomeRF.

16. (Previously Presented) The method of claim 2, wherein the server compares transmission time of entire A/V streams during which a header of the server reads A/V streams simultaneously.

17. (Previously Presented) The method of claim 2, wherein, when an A/V stream transmission time of the server is slower than a defined transmission time of the A/V stream, a server unavailableness message is provided to the renderer to achieve smooth outputting of A/V streams of the server.

18. (Previously Presented) A method for outputting streams through a home network, the method comprising:

connecting plural renderers to a server request A/V streams;

judging, by the server, whether the A/V streams can be outputted in response to requests from the renderers; and

providing, by the server, the A/V streams to the renderers sequentially or simultaneously when the A/V streams can be outputted,

wherein, in judging whether A/V streams can be outputted, the server compares a transmission time of entire A/V streams and a stream transmission time according to a defined

reproduction capability of the server required for reproducing A/V streams, and then judges whether the A/V streams can be outputted based on a result of the comparison.

**B. Evidence Appendix**

Four page Adobe Developer Center Article: Calculating bandwidth needs for Flash media Server - filed as an attachment to the Amendment filed on May 27, 2008

Microsoft Press Computer Dictionary Third Edition (1997) – relied upon in the Advisory Action dated June 16, 2008, but not attached to the Advisory Action.

**C. Related Proceedings Appendix**
**(No Related proceedings)**